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MAILED

MAY 05 2010

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

In re Application of: PITHAWALA, Burjiz et. al.
Application No. **10/803,772**
Filed: March 17, 2004
Docket No. 50325-0829
Title: METHOD AND APPARATUS
PROVIDING DEVICE-INITIATED
NETWORK MANAGEMENT

DECISION ON PETITION
UNDER 37 C.F.R. § 1.181

This is a decision on petition filed December 15, 2009 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner to seeks relief from Examiner's action in relation to the Final Office Action mailed December 02, 2009, *namely*, requesting the withdrawal of the finality thereof.

This petition is **DISMISSED AS MOOT**.

RELEVANT HISTORY PROSECUTION

03/23/09 Non-final office action was mailed, wherein Claims 1, 34, and 42 were rejected under 35 U.S.C. 102(e) as being anticipated by Lavian et al ; Claims 35-37 and 54-57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lavian et al. in view of Green et al.; Claims 28, 33, 48, and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Herrmann et al. ; Claims 38-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lavian, in view of Green, and further in view of Davies; *Claims 2-6, 43-47, and 58-61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green, in view of Lavian, and further in view of Davies*; Claims 29-32 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green, in view of Davies and further in view of Herrmann. The action additionally rejected claim 28 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As it was not described in a clear manner what one or more triggers defined by the first and what report information defined by the second definition are.

- 06/23/09 Reconsideration/Reply under 37 C.F.R. §1.111 was filed which included amendments to: (i) claims **34** and **54**; (ii) claims 1, 3-6, 28-33, 35-53, and 56-61 were canceled; (iii) claims 62-98 were added.
- 12/02/09 Final office action was mailed, wherein (i) claims 2, 34, 54, 62- 65, 67-71,77, 83-86, 88- 92, and 98 were rejected under 35 U.S.C. 102(b) as being anticipated by Karjala et al.; claims 72 and 93 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala in view of Green et. al.; claims 66, 78-82, and 87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala in view of Davies; claims 73-76 and 94-97 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala, in view of Green, and further in view of Davies.
- 12/15/09 Petition under 37 CFR § 1.181 *requesting* the withdrawal of the finality.
- 03/04/10 Second final office action was mailed, wherein (i) claims 34, 54, 62- 65, 67-71,77, 83- 86, 88-92, and 98 were rejected under 35 U.S.C. 102(b) as being anticipated by Karjala et al.; claims 72 and 93 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala in view of Green et. al.; claims 66, 78-82, and 87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala in view of Davies; claims 73-76 and 94-97 were rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala, in view of Green, and further in view of Davies. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green, in view of Lavian et al. and further in view of Davies.

REGULATION AND PROCEDURES

803.02 Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry *if they do not* comply with the requirements of 37 C.F.R. §1.116. See MPEP § 714.13.

1.115 Preliminary Amendments: § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (a) An amendment after final action must comply with § 1.114 or this section. (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title): (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action.

706.07(a) [R-6] Final Rejection, When Proper on Second Action

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected

to be claimed. See MPEP § 904 et seq. However, note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph).

1207.04 [R-3] Reopening of Prosecution After Appeal

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits.

DECISION

Final office action mailed December 02, 2009 (hereafter referred to a Final action) for which Petitioner seeks relief of Examiner's action, specifically, its final designation, has been fully considered.

Final action was mailed in response to Amendment filed 06/23/09. This Response did **not** include amendments to (at least) claim 2. Nevertheless, the final rejection included new grounds of rejection for claim 2, namely, a rejection under 35 U.S.C. 102(b) as being anticipated by Karjala et al. These new grounds were **not** necessitated by Applicants' amendment or based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c).

However, second final office action mailed 03/04/10 restitutes the grounds of rejection of claim 2 in accordance with non-final office action mailed 03/23/09. That is, second final office action rejects unamended claim 2 under 35 U.S.C. 103(a) as being unpatentable over Green, in view of Lavian et al. and further in view of Davies. Thus, the finality of second office action is deemed proper.

For the reason(s) above-mentioned this petition is hereby **dismissed as moot**.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huynh, Quality Assurance Specialist, can be reached at (571) 272-4147.

/Beatriz Prieto/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,772	03/17/2004	Burjiz Pithawala	50325-0829	8045

29989 7590 05/05/2010
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EXAMINER

HENRY, MARIEGEORGES A

ART UNIT	PAPER NUMBER
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2455

MAIL DATE	DELIVERY MODE
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05/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.